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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,759	02/26/2002	Makoto Fukumoto	MM4522	2261

7590 06/13/2005

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EXAMINER	
PSITOS, ARISTOTELIS M	
ART UNIT	**PAPER NUMBER**
2653	

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/083,759	FUKUMOTO ET AL.	
	Examiner	Art Unit	
	Aristotelis M. Psitos	2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 February 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Applicant's response of 2/17/05 has been considered with the following results.

Drawings

The drawings are no longer objected to.

Information Disclosure Statement

The submitted IDS have been reviewed and made of record with the exception of the submitted JP report since it is in Japanese and no English equivalent exists.

Response to Arguments

With respect to the above objected to JP search report. The examiner has made of record all of the cited prior art. The examiner is not making the JP search report of record for the reason(s) stated above. Applicant has submitted a certified English translation of their priority papers, and such is acknowledged.

Claim Objections

Claims 10-15 are objected to because of the following informalities: the terms "storage unit" and "control unit" are not readily apparent from the remainder of the specification. Applicant is reminded of the requirements of 37 CFR 1.75 (d) (1). Appropriate correction is required.

The examiner interprets "storage unit" as the record medium.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 10 and 13 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2000-285485 further considered with Kubo et al.

The following analysis is made:

Claim 13	JP 2000-285485
In an optical disk drive	see abstract
that can write data in an optical disk	see paragraph 25 of the MAT
at a plurality of rotative modes,	
a method of determining an optimum	
tracking offset value of the optical disk,	
the method comprising the steps of :	

reading the information indicating how the tracking offset value is to be varied corresponding to each of a plurality of rotative modes',	see paragraph 23 of the MAT
writing test data in a first plurality of frames of the optical disk using the , tracking offset value being varied based on the information,	see paragraphs 23-26 of the MAT
reading the test data written in the first plurality of frames thereby to obtain characteristic values of the first plurality of frames, and	see above paragraphs 23-26 of the MAT
determining the optimum tracking offset value of the optical disk drive based on the obtained characteristic values.	see paragraphs 23-26 of the MAT

The MAT (machine assisted translation) of the JP document was provided to applicant's representative in the previous OA.

As analyzed above the JP document discloses a system in which through a test writing procedure optimum tracking offset values is determined.

These values are written to the disc (inherently written since they are reproduced accordingly) and upon such reading the optimum tracking offset is determined. Applicant's attention is drawn to paragraphs 23-26 of the MAT.

The above passages do detail the ability of having a plurality of various rotation modes – see in particular paragraph 25 of the MAT, as well as the ability of writing such – see paragraphs 19-22 of the MAT as well.

Hence, the examiner concludes that the above claimed limitations are present.

With respect to apparatus claim 10, the claimed hardware is inherently present, else the system could not perform as disclosed.

If applicant can convince the examiner the claimed elements (storage unit) and control unit are not inherently present in the above JP document, then the examiner would further rely upon the Kubo reference which discloses in this environment, a "control unit", cpu well known in this environment to perform the appropriate control ability, read, write, etc. Such control units are notoriously old and well-known and official notice is taken thereof.

It would have been obvious to modify the base system of the above noted JP document with Kubo and Official notice so as to permit the above JP system to perform the recited optimum tracking offset ability.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

2. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 10 and 13 above, and further in view of Yoshida et al and Kelly.

The ability of repeating the test writing procedure to a plurality of second frames, is taught by the Yoshida et al system – note the described ability of performing test writing to a plurality of test regions by the appropriate write cycle. The examiner has interpreted the beta value of the base JP reference as the claimed characteristic value(s). The Yoshida et al reference further teaches – see col. 15 starting at line 27 with respect to the description of figure 12(b) the ability of obtaining an "average" of the peak and bottom values. Furthermore, the ability of "obtaining" an average of characteristic values is further taught by Kelly – see the description of such characteristics starting at col. 2 line 20 and continuing till col. 3 line

60.

It would have been obvious to modify the base system as described above in paragraph one of this OA, with the additional teachings from the Yoshida et al document, motivation is to permit the optimization of system parameters through the disc as a dynamic capability, as opposed to a static, once only ability as well as an average and further with Kelly who also teaches such abilities, so as to obtain a optimize system.

3. Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 11 and 14 above, and further in view of either Kono or JP 3057875.

Although the above documents provide for writing the test signal(s) at a plurality of test areas, the claimed "frames" are not specifically clearly depicted. Although the examiner concludes such "frame" ability is inherently present in the above systems, such an ability/limitation is further specified by either Kono or JP 3057875 submitted by applicants.

It would have been obvious to modify the base systems as relied above in paragraph 2 with the additional ability of having the test signals appropriately recording in a plurality of frames, motivation is to ensure the proper recording power level across the record medium.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 10-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6859426 in view of either Wu or the above noted JP document relied in paragraph 1.

The subject matter claimed in the instant application is disclosed in the patent and claimed as follows:

a) the claimed average calculation part and the claimed optimum write power setting part of the US patent meets the claimed apparatus limitations as presented in the above pending claims, with the exception noted below.

b) the method limitations of the present application is met, when the above claimed apparatus of the US patent operates.

Exception: claimed language of claim 10 recites function of the storage unit with respect to a plurality of rotative modes, and the equivalent step in claim 13.

Such a capability is further taught by either the above noted JP document relied upon in paragraph 1 or Wu reference – see the description in the abstract for instance wherein there is stored appropriate write control signals for various rotation modes, i.e., 1x,2x, etc., and such permits the combined system to provide for multispeed (rotation mode) for variable speed systems – i.e., reproduction of records at 1x, 2x, 3x, etc., recording/reproduction speeds.

The overall claimed invention in the present application is hence considered met by the above documents.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

Since the discover of the above noted patent to Ogawa et al/6859426, applicant is reminded of his duty in presenting any relevant information (e.g., prior art) with respect to the claimed invention in the present US application.

Ohtuska is cited as illustrative of another prior art laser power control system including rotational position determination (rotary angle).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner
Art Unit 2653